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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,218

06/05/2006

Shuichi Hirata

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EXAMINER

KIM, PAUL D

ART UNIT

PAPER NUMBER

3729

NOTIFICATION DATE

DELIVERY MODE

02/12/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
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Office Action Summary	Application No. 10/596,218	Applicant(s) HIRATA ET AL.	
	Examiner Paul D. Kim	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-21 is/are allowed.
- 6) ☒ Claim(s) 7-9 and 12-14 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/21/2008 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7-9, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant Admitted Prior Art.

Applicant Admitted Prior Art (APA hereinafter) teaches a process of controlling a contact load comprising steps of: moving a head (30) down by a predetermined distance (such as 0.1 mm/s) at a second speed (a low speed) as shown in Fig. 5A; measuring the contact load after moving the head down; and determining whether the measured contact load has reached the target contact load, the moving and measuring being repeated until the measured contact load reaches the predetermined target

contact load as shown in Fig. 6 (see also specification, line 16 on page 2 to line 8 on page 4).

As per claim 8 the head of APA is moved down slightly by the second speed and then measured the load as shown in Figs. 7B and 7C (see also from line 21 on page 3 to line 15 of page 4). Therefore, the head is inherently halted for a predetermined period of time after moving the head down and before measuring the contact load.

As per claims 9 and 13 the predetermined distance is adjustably set in accordance with the target contact load as shown in Figs. 7A-7C.

As per claim 12 the measuring of the contact load is repeated until a different contact load (such as the target contact load) is reached as shown in Figs. 7A-7C.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over APA.

APA teaches all of the limitations as set forth above, but fails to disclose a range of the predetermined distance. APA teaches that the head of APA is moved down slightly by the second speed and then measured the load as shown in Figs. 7B and 7C (see also from line 21 on page 3 to line 15 of page 4). At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary

skill in the art to measure the contact load by a range of the predetermined distance as recited in the claimed invention because Applicant has not disclosed that measuring the contact load by a range of the predetermined distance as recited in the claimed invention provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with APA because measuring the contact load by a range of the predetermined distance as recited in the claimed invention would perform equally well such as monitoring whether the head is contacted the substrate or not in APA. Therefore, it would have been an obvious matter of design choice to modify measuring the contact load by a range of the predetermined distance of APA to obtain the invention as specified in claim 14.

Allowable Subject Matter

5. Claims 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 15-21 are allowed.

Response to Arguments

7. Applicant's arguments with respect to claims 7-21 have been considered but are moot in view of the new ground(s) of rejection.

8. According to Figs. 7A-7C of APA, the head is moved down slightly to measure the predetermined distance until the head is contacted the substrate. The velocity of the second speed (0.1 mm/s) is correlation with the time and the distance as shown in Figs. 7A-7C. In addition, the head of APA is moved down slightly by the second speed and then measured the load and repeatedly moved down the head until the head is contacted the substrate.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D. Kim whose telephone number is 571-272-4565. The examiner can normally be reached on Monday-Thursday between 6:00 AM to 2:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul D Kim/
Primary Examiner, Art Unit 3729